

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and the following remarks.

By the foregoing amendment, claims 29-32, 34-35 and 57 have been amended. No new matter has been added. Further to a telephone conversation with the Applicants' representative, Mr. John Harrop, on March 21, 2005, the Examiner has withdrawn claim 79 from consideration. However, the Applicants traverse the restriction requirement, as outlined in full detail below. Thus, claims 1-79 are pending in this application and subject to examination.

Response to Election/Restriction Requirement

In the Office Action mailed April 25, 2005, the Examiner issued a requirement to restrict the present application to one of the following inventions: Group I, including claims 1-78, which the Examiner indicates is drawn to a virtual on-demand electronic book system, and Group II, including claim 79, which the Examiner indicates is drawn to a user interface. A provisional election was made on March 21, 2005, during a telephonic conference with Applicant's representative John Harrop, to prosecute the invention of Group I, claims 1-78, without traverse. The Applicants hereby confirm the provisional election of the claims of **Group I, 1-78**, which the Examiner has indicated are drawn to a virtual on-demand electronic book system. The Applicants reserve the right to file one or more divisional applications directed to the non-elected claims. However, this election is made **with traverse**, as the Applicants respectfully submit that examination of all claims presents no undue burden on the Examiner. Consideration of all pending claims and issuance of a Notice of Allowance are earnestly solicited.

Formal Matters

The Office Action objected to claims 29-37 as being ambiguous when identifying the larger/outer queue. To correct these perceived ambiguities, the Examiner recommended using the term --super queue-- in place of "the queue," and the term --one or more additional queues-- in place of "one or more second queues." Claims 29-37 have been amended in accordance with the Examiner's recommendations. The Applicants respectfully request withdrawal of the objection.

Claim 9 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner takes the position that the claimed "service time guarantee" is not described in the specification in a way as to enable one skilled in the art to make and/or use the invention. The Applicants respectfully traverse this rejection. The "service time guarantee" is described, in compliance with 35 U.S.C. § 112, first paragraph, at least on page 72, line 26 through page 73, line 6, and page 78, lines 19-25 of the specification. Therefore, the Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 30-35 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner takes the position that it is unclear what is meant by the claimed "one or more second queues." Claims 30-32 and 34-35 have been amended responsive to this rejection. Reconsideration and withdrawal of the rejection are respectfully requested.

With respect to claims 57-58, the Examiner takes the position that there is a lack of antecedent basis for the recited "the second sections." Claim 57 has been amended to correct the perceived lack of antecedent basis. Applicants thus request

reconsideration of claims 57-58 and withdrawal of any pending objections and/or rejections.

Claims 65-78 are Directed to Statutory Subject Matter Under 35 U.S.C. § 101

Claims 65-78 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Citing to page 76, lines 18-21 of the specification, the Examiner takes the position that “the computer-readable medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., hardware) and intangible embodiments (e.g., software),” and is therefore non-statutory subject matter. See Office Action, at pages 5-6. The Applicants respectfully traverse this rejection, as follows.

35 U.S.C. § 101 recites in relevant part, “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor . . .” Claims 65-78 of the present application are directed to “a computer-readable data transmission **medium** . . . comprising: a storage module . . .; a broadcast module . . .; and . . .an electronic book order module that receives and processes orders from the readers . . .,” as recited in independent claim 65 (emphasis supplied). The Applicants respectfully submit that the claimed “a computer-readable data transmission medium” is an article of manufacture, and is therefore expressly included in one of the categories of statutory subject matter provided in 35 U.S.C. §101. The Applicants further submit that whether or not embodiments described in the specification are “tangible” or “intangible” is not a relevant inquiry when determining whether claimed subject matter is statutory or non-statutory.

For at least these reasons, the Applicants respectfully submit that claim 65 is directed to statutory subject matter. Each of claims 66-78 depends from claim 65, and is therefore directed to statutory subject matter for at least the same reasons as claim 65.

Claims 38-64 Recite Patentable Subject Matter

Claims 38-46, 50-56, 59-61 and 63-64 are rejected under 35 U.S.C. § 102(b) as being anticipated by International Application Published Under the Patent Cooperation Treaty, International Publication No. WO 95/15649 to Hendricks (hereinafter the "Hendricks PCT application"). Claim 47 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendricks as applied to claim 39, in view of U.S. Patent No. 6,252,876 B1 to Brueckheimer et al. (hereinafter "Brueckheimer"). Claim 57 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendricks as applied to claim 55, in view of U.S. Patent No. 6,813,249 B1 to Lauffenburger et al. (hereinafter "Lauffenburger"). Claim 58 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendricks in view of Lauffenburger as applied to claim 57, further in view of U.S. Patent No. 5,790,935 to Payton (hereinafter "Payton"). Claim 62 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendricks as applied to claim 60, in view of Payton.

These rejections are respectfully traversed for the following reasons. The Applicants submit that the Hendricks PCT application is not an appropriate reference for a rejection of claims 38-64 under 35 U.S.C. §§ 102(b) or 103(a). The Hendricks PCT application claims priority to U.S. Application Serial Nos. 08/160,194, 08/160,281 and 08/336,247. The present application is a continuation-in-part from all three of those

applications. All of the features in the Hendricks PCT application that the Examiner cites to in rejecting claims 38-64 are supported in at least one of these three priority applications. Therefore, the Hendricks PCT application is not an appropriate reference for the rejection of claims 38-64 under 35 U.S.C. §§ 102(b) or 103(a), and the Applicants request withdrawal of this rejection.

Claim 1-17 and 29-37 Recite Patentable Subject Matter

Claims 1-3, 6-8, 10 and 14-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Payton in view of Lauffenburger. Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Payton in view of Lauffenburger as applied to claim 3, further in view of U.S. Patent No. 6,611,531 B1 to Chen et al. (hereinafter "Chen"). Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Payton in view of Lauffenburger and Chen as applied to claim 4, further in view of U.S. Patent No. 5,881,269 to Dobbelstein (hereinafter "Dobbelstein"). Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Payton in view of Lauffenburger as applied to claim 1, further in view of U.S. Patent No. 6,556,561 B1 to Himbeault et al. (hereinafter "Himbeault"). Claims 11 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Payton in view of Lauffenburger as applied to claim 10, further in view of U.S. Patent No. 5,903,901 to Kawakura et al. (hereinafter "Kawakura"). Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Payton in view of Lauffenburger as applied to claim 1, further in view of U.S. Patent No. 6,034,680 to Kessenich et al. (hereinafter "Kessenich"). Claims 29-30, 33 and 36 are rejected under 35 U.S.C. § 102(b) as being anticipated by Payton. Claim 31 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Payton as applied to claim 30, in view of

Chen. Claim 32 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Payton as applied to claim 30, in view of U.S. Patent No. 5,923,656 to Duan et al. (hereinafter "Duan"). Claims 34 and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Payton as applied to claim 30, in view of Lauffenburger. Claim 37 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Payton as applied to claim 29, in view of U.S. Patent No. 5,790,176 to Craig (hereinafter "Craig"). The Applicants note that claims 29-32 have been amended. To the extent that these rejections remain applicable to the currently pending claims, these rejections are respectfully traversed, as follows.

The Applicants submit that Payton is not an appropriate reference for a rejection of claims 1-17 and 29-37 under 35 U.S.C. §§ 102(b) or 103(a). The Applicants submit that each of the elements of claims 1-17 and 29-37 is supported in at least one of U.S. Application Serial Nos. 08/160,194 (filed on December 2, 1993), 08/160,281 (filed on December 2, 1993) or 08/336,247 (filed on November 7, 1994), to which the present application claims priority. As the filing dates of these applications are well before the earliest priority date of Payton (January 30, 1996), the Applicants respectfully submit that Payton is not a proper reference that may be used to reject claims 1-17 and 29-37 under 35 U.S.C. §§ 102(b) or 103(a). For at least these reasons, the Applicants request withdrawal of these rejections.

Claims 18-28 and 65-78 Recite Patentable Subject Matter

In the Office Action, the Examiner alleges claims 18-28 "contain aspects similar to those disclosed in claims 1-17 and are rejected under the same rationale." See Office Action, at page 19, item 23. Similarly, the Examiner alleges claims 65-70, 73-75

and 77-78 "contain aspects similar to those disclosed in claims 51-56, 59-61 and 63-64 respectively and are rejected under the same rationale." See Office Action, at page 9, item 15. Similarly, the Examiner asserts that claims 71-72 and 76 "contain aspects similar to those disclosed in claims 57-58 and 62 respectively and are rejected under the same rationale." See Office Action, at page 27, item 32. For the reasons set forth above, the Applicants respectfully submit that the Hendricks PCT Application and Payton are not proper prior art references that may be used to reject claims 1-17 and 29-64 of the present application under 35 U.S.C. §§ 102(b) or 103(a). The Applicants respectfully submit that, for the same reasons, the Hendricks PCT Application and Payton cannot be used to reject claims 18-28 and 65-78. Furthermore, the rejection of claims 18-28 and 65-78 is respectfully traversed as being incomplete for failing to provide information such as particular figure(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s), and/or any relevant comments sufficient for the Applicant to determine further the propriety of the rejection. For the foregoing reasons, the Applicants respectfully request withdrawal of the outstanding rejections.


Conclusion

For all of the above reasons, it is respectfully submitted that the claims now pending recite patentable subject matter. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300, referring to client-matter number 026880-00000. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, referring to client-matter number 026880-00004.

Respectfully submitted,


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Enclosure: Petition for Extension of Time (3 months)